

# Notice of Allowability

## Application No.

09/690,044

## Examiner

Celia Chang

## Applicant(s)

LINDBERG ET AL.

## Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--  
claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included with (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

☒ This communication is responsive to IDS filed 10/4/04 and preliminary amendment dated 07/08/04.

☒ The allowed claim(s) is/are 1 and 43-53.

☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements set forth below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.

b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

Notice of References Cited (PTO-892)

Notice of Draftsperson's Patent Drawing Review (PTO-948)

Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_

Examiner's Comment Regarding Requirement for Deposit  
of Biological Material


5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_

7. ☐ Examiner's Amendment/Comment

8. ☒ Examiner's Statement of Reasons for Allowance

9. ☐ Other \_\_\_\_\_

  
Celia Chang  
Primary Examiner  
Art Unit 1625

Art Unit: 1625

### DETAILED ACTION

1. This application is a RCE of SN 09/690,044 filed Oct. 4, 2004.

A preliminary amendment was filed on July 8, 2004. Claims 2-42 have been canceled. Claims 1, 43-53 are pending.

A 1449 was filed on Oct. 4, 2004 which has been considered and an initialed copy is attached.

2. *Reason for Allowance*

The following is an examiner's statement of reasons for allowance:

Applicants have made of record an opposition proceeding before the EPO with respect to the patent family application of the instant claims. The most relevant references in the opposition proceeding are EP0124495 and DE4035455 and both references were recited on the PTO-1449 dated Oct. 16, 2000 and were considered by the examiner during prosecution. The chemical compound structures corresponding to EP0124495 (CA102:137795) and DE4035455 (CA117:90285) were carefully compared to the instant claims. The EP0124495 disclosed racemate complex of the magnesium salt of (+)-5-methoxy-2-[[[(4-methoxy-3,5-dimethyl-2-pyridinyl)methyl]sulfonyl]-1H-benzimidazole. The DE4035455 disclosed no magnesium salt only the free base of (-)-5-methoxy-2-[[[(4-methoxy-3,5-dimethyl-2-pyridinyl)methyl]sulfonyl]-1H-benzimidazole. Since the omeprazole free base is known to racemize thus does not render pure enantiomeric salt preparation using the free base obvious (see CA 114:74595). Therefore, the instant claims explicitly pointing to the single, nonracemic magnesium salt of (-)-5-methoxy-2-[[[(4-methoxy-3,5-dimethyl-2-pyridinyl)methyl]sulfonyl]-1H-benzimidazole with a purity limitation is neither anticipated nor rendered obvious by the art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

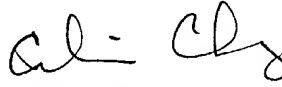
Art Unit: 1625

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
Oct. 26, 2004

  
Celia Chang  
Primary Examiner  
Art Unit 1625